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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 3674**
Ryan D. EGELAND : Attorney Docket No. 2006_0521A
Serial No. 10/574,818 : **Group Art Unit Not Yet Assigned**
Filed April 6, 2006 : Examiner Bryan Lin

ELECTROCHEMICAL TREATMENT
OF SUBSTRATES

Mail Stop: PCT

RENEWED PETITION UNDER 37 CFR 1.47(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO 23-0975

Sir:

This is responsive to the PTO Decision dated June 29, 2007.

The Decision requests proof that a bona fide attempt has been made to present a complete copy of the application papers to Dr. Egeland for his signature. The Decision states that the proof of record only demonstrates that OGT attempted to provide him with the Declaration and Assignment papers for execution.

In reply, there is submitted herewith a Supplemental Declaration of Michael Bennett together with Appendices 1, 2, 3 and 4.

It is respectfully submitted that these documents provide proof that a bona fide attempt has been made to present a complete copy of the application papers to Dr. Egeland for his signature. It is respectfully submitted that such proof supplements the clear and convincing evidence presented with OGT's original Petition that the inventor has refused to cooperate in joining in this application.

The Decision further requests further proof that Dr. Egeland created the claimed subject matter while employed by OGT.

In reply, there is submitted herewith a Declaration of Edwin Southern and a Declaration of Peter Hotten, together with Appendices A and B.

It is respectfully submitted that such evidence provides additional proof that Dr. Egeland did create the claimed subject matter while employed by OGT, particularly when considered with the original evidence submitted with the original Petition.

In summary, it is respectfully submitted that each requirement of 37 CFR 1.47(b) has been satisfied.

It is further noted that OGT has paid considerable sums of money to Dr. Egeland for development of the invention described and claimed in this application. The corresponding British and International applications have been published. The filing of this application in the U.S. is necessary to preserve the rights of OGT. The loss of this application would result in loss of OGT's rights to patent protection for this invention in the U.S. OGT would suffer irreparable damage from the loss of patent protection for the invention in the U.S.

If the Petition's Examiner has any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Favorable consideration and acceptance of the Declaration is solicited.

Respectfully submitted,

Ryan D. EGELAND

By: Warren M. Cheek
Warren M. Cheek
Registration No. 33,367
Attorney for Applicant

WMC/dlk
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
August 29, 2007



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 3674
Ryan D. EGELAND : Attorney Docket No. 2006_0521A
Serial No. 10/574,818 :
Filed April 6, 2006 :

ELECTROCHEMICAL TREATMENT
OF SUBSTRATES

SUPPLEMENTAL DECLARATION UNDER 37 C.F.R. 1.47 (b) AND 35 U.S.C. 118

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I am Michael Bennett, Vice President for Licensing and Patents at Oxford Gene Technology (OGT). I am the same Michael Bennett who was signatory to the Statement of Facts filed in support of the Petition Under 37 CFR 1.45(c) and 35 USC 118, filed at the USPTO on 20th June 2007.
2. When instructing Kate Lingard on 4th May 2006, 13th June 2006, 27th July 2006 and 2nd October 2006 to send a letter to Dr. Egeland enclosing a copy of the Declaration and Power of Attorney form, I did not believe it was necessary to furnish Dr. Egeland with a copy of the application papers as I was informed that he had already been made aware of the application's existence and the fact of its filing.
3. On 8th August 2007, I sent a letter (Appendix 1) to Dr. Egeland at his address at Chicago, Illinois by FedEx Express. The letter enclosed a copy of a Declaration and Power of Attorney form, an Assignment form and a copy of the full published international patent application, that is WO 2005/037425, corresponding to International Application No. PCT/GB2004/004390 and

to the instant U.S. national stage application. FedEx Express provided me with an Air Waybill receipt (Appendix 2).

4. On 9th August 2007, I accessed the FedEx Express online tracking facility (Appendix 3) which showed that Dr. Egeland was not available and that the letter could not be delivered.

5. On 14th August 2007, I accessed the FedEx Express online tracking facility (Appendix 4) which showed that Dr. Egeland had not been available on three occasions and that the letter had been returned to the local FedEx facility.


6. On 15 August 2007, I received a telephone call from FedEx Express, requesting a contact telephone number for Dr. Egeland. I provided FedEx Express with the telephone number (001) 312 47 5200, which was the last known contact number of Dr. Egeland as stated on his website which was accessed by Gill Howells on 8th August 2006 and has since remained unchanged.

7. On 28th August 2007, I accessed the FedEx Express online tracking facility (Appendix 5) which showed that the letter had still not been delivered and remained at the local FedEx facility.

I further declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Date:

28/8/07


(Michael Bennett)

①



7 August 2007

Dr. Ryan Egeland,
1809 N. Lincoln Park West,
Apt B1,
Chicago,
IL 60614,
USA

Our Ref: 8/US-1

Dear Ryan,

OGT Patent Family 8 – Electrochemical Treatment of Substrates International Patent Application No. PCT/GB2004/004390 published as WO2005/037425

The family 8 patent application, for which you are a named inventor, has reached the national stage and OGT is taking prosecution of the patent forward in Europe, Japan and the USA.

To proceed with a US patent application it is standard practice for all named inventors to sign to documents:-

1. Declaration and Power of Attorney form
2. Assignment form

The Declaration and Power of Attorney form allows the US patent attorney firm Wenderoth, Lind and Penack to accept instructions from Carpmals and Ransford on our behalf as only US firms have the authority to transact business with the US patent office. The Assignment Form gives OGT IP Ltd the right to be named as the Assignee on the patent.

Please can you sign and date the enclosed Declaration and Power of Attorney form (oin Page 3) and sign and date the Assignment document (on page 2) in the presence of two witnesses. Can you return both documents to me as soon as possible so that we can progress examination of the application as soon as possible.

I have enclosed a copy of the published patent application along with copies of each form for your own records.

Yours sincerely

Dr. Michael Bennett
Vice President Licensing and Patents

Enc. Declaration and Power of Attorney form, Assignment form, Patent application WO2005/037425

FedEx International Air Waybill

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1 From Please print and use legibly

Date 08/10/02 Sender's FedEx Account Number 2656 2819-2

Sender's Name MICHAEL BENNETT Phone 444 186585288

Company OXFORD GENE TECHNOLOGY

Address BEBBROOK SCIENCE PARK

Address SANDY LAKE

City YARLTON State Province OXON

Country U.K. Postal Code OX51AF

Sender's VAT/TURN Number 418 33835

2 To Recipient's Name DR RYAN EGELAND Phone

Company 1809 N. LINCOLN PARK WEST

Address APT B1

Address

City CHICAGO State Province IL

Country USA ZIP Postal Code 60614

Recipient's Tax ID number for Customs purposes

3 Shipment Information

Total Packages 1 Total Weight 0.5 lbs. DIM L / W / H 1 / 1 / 1

Country of Origin

Country of Manufacture

Value for Customs

DOCUMENTS

Total Declared Value for Customs

Specify Currency

Sender's Copy

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5 Packaging

6 Special Handling

7a Payment

7b Payment

8 Your Internal Billing Reference

9 Required Signature

For Completion Instructions, see back of fifth page.

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For a full version of our Conditions of Carriage, please visit our Web site at fedex.com. Non-Hip-Hop International Air Waybill - 00554-2001 Federal Express Corporation

Track Shipments

Detailed Results

[? Quick Help](#)

Tracking number	856481667120	Reference	POR 278
Ship date	Aug 8, 2007	Destination	CHICAGO, IL
Estimated delivery	Aug 10, 2007 by 10:30 AM	Service type	Priority Envelope
		Weight	0.5 kgs.
Status	Delivery exception		

Date/Time	Activity	Location	Details
Aug 9, 2007	9:11 AM Delivery exception	CHICAGO, IL	Customer not available or business closed - Signature required
	7:49 AM On FedEx vehicle for delivery	CHICAGO, IL	
	7:10 AM At dest sort facility	CHICAGO, IL	
	6:17 AM At local FedEx facility	CHICAGO, IL	
	1:27 AM Int'l shipment release	NEWARK, NJ	
	12:40 AM Arrived at FedEx location	NEWARK, NJ	
Aug 8, 2007	9:43 PM In transit	STANSTED GB	
	4:09 PM Left origin	AYLESBURY GB	
	1:48 PM Picked up	AYLESBURY GB	

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E-mail address	Language	Exception updates	Delivery updates
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	English	<input type="checkbox"/>	<input type="checkbox"/>
	English	<input type="checkbox"/>	<input type="checkbox"/>
	English	<input type="checkbox"/>	<input type="checkbox"/>

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Track Shipments Detailed Results

[? Quick Help](#)

4

Tracking number	856481667120	Reference	POR 278
Ship date	Aug 8, 2007	Destination	CHICAGO, IL
		Service type	Priority Envelope
		Weight	0.5 kgs.

Status At FedEx destination

Date/Time	Activity	Location	Details
Aug 13, 2007	6:16 PM At local FedEx facility	CHICAGO, IL	
	9:18 AM Delivery exception	CHICAGO, IL	Customer not available or business closed - Signature required
	7:26 AM On FedEx vehicle for delivery	CHICAGO, IL	
Aug 10, 2007	9:27 AM Delivery exception	CHICAGO, IL	Customer not available or business closed - Signature required
	7:54 AM On FedEx vehicle for delivery	CHICAGO, IL	
Aug 9, 2007	9:11 AM Delivery exception	CHICAGO, IL	Customer not available or business closed - Signature required
	7:49 AM On FedEx vehicle for delivery	CHICAGO, IL	
	7:10 AM At dest sort facility	CHICAGO, IL	
	6:17 AM At local FedEx facility	CHICAGO, IL	
	1:27 AM Int'l shipment release	NEWARK, NJ	
	12:40 AM Arrived at FedEx location	NEWARK, NJ	
Aug 8, 2007	9:43 PM In transit	STANSTED GB	
	4:09 PM Left origin	AYLESBURY GB	
	1:48 PM Picked up	AYLESBURY GB	

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E-mail address	Language	Exception updates	Delivery updates
	English	<input type="checkbox"/>	<input type="checkbox"/>
	English	<input type="checkbox"/>	<input type="checkbox"/>
	English	<input type="checkbox"/>	<input type="checkbox"/>
	English	<input type="checkbox"/>	<input type="checkbox"/>

Select format: ☒ HTML ☐ Text ☐ Wireless

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 3674
Ryan D. EGELAND : Attorney Docket No. 2006_0521A
Serial No. 10/574,818 :
Filed April 6, 2006 :

ELECTROCHEMICAL TREATMENT
OF SUBSTRATES

DECLARATION UNDER 37 C.F.R. 1.47 (b) AND 35 U.S.C. 118

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I am Peter Hotten, Director of Licensing and Patents at Oxford Gene Technology (OGT). I am responsible for overseeing the administration of patent applications on behalf of Oxford Gene Technology IP Limited. I am the same Peter Hotten who received an email from Edwin Southern on 8th September 2006 concerning Dr. Egeland's email address.
2. I confirm that Dr. Egeland was employed by OGT between the dates of 1st October 2003 and 18th June 2004 and was employed as a Consultant between the dates of 1st July 2004 and 30th September 2004 and between the dates of 1st October 2004 and 30th September 2005.
3. During his employment at OGT, I witnessed Dr. Egeland being fully involved in drafting, reviewing and amending the text which was used as basis for international patent application no. PCT/GB2004/004390. For example:

4. On 7th October 2003, before a patent application had been filed and when the application was still in draft form, I received an email (Appendix A) from Dr. Egeland informing me that any questions regarding the draft application may be directed to him.

5. On 14th October 2003, also before a patent application had been filed and when the application was still in draft form, I received an email (Appendix B) from Dr. Egeland addressed to Jennifer Cox at Carpmaels & Ransford informing us that information which he had provided would be useful in drafting the patent and that any further queries should be directed to me.

6. I confirm that Dr. Egeland was subsequently made aware of the filing of the international application.

I further declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Date: 28 Aug 07

A handwritten signature in black ink, appearing to read 'P. Hotten', written over a horizontal line.

(Peter Hotten)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 3674**
Ryan D. EGELAND : **Attorney Docket No. 2006_0521A**
Serial No. 10/574,818 :
Filed April 6, 2006 :

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OF SUBSTRATES

DECLARATION UNDER 37 C.F.R. 1.47 (b) AND 35 U.S.C. 118

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. I am Edwin Southern, Chairman and Chief Scientific Officer of Oxford Gene Technology (OGT). I am the same Edwin Southern who sent an email to Peter Hotten on 8th September 2006 concerning Dr Egeland's email address.
2. In my post as Professor of Biochemistry at the University of Oxford, I was a supervisor of Dr. Egeland's doctorate.
3. Subsequently, in my post as Chairman and Chief Scientific Officer of Oxford Gene Technology (OGT), I worked with and supervised Dr. Egeland during his employment at OGT.
4. The international patent application number PCT/GB2004/004390 was written by Dr Egeland whilst he was employed by OGT and whilst he was under my supervision.

I further declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were

made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Date: 29.08.07

A handwritten signature in black ink, appearing to read 'Edwin Southern', is written over a horizontal line.

(Edwin Southern)

FROM: "Ryan D. Egeland" <ryan.egeland@oxamer.com>
SENT: 07/10/03 18:17:34
TO: C.M@carpmaels.com
CC: , pete.hotten@ogt.co.uk

A

SUBJECT: Patent Draft #1

Cameron, Pete,

Just to advise, I will be away from 12 Oct and upon my return on 16 Aug AM will be meeting with [REDACTED] and technical representatives for in-depth technical discussions. Three points to deal with ASAP:

1) If there are further technical queries on the patent draft, you can reach me through Thursday this week.

2) Otherwise, could you please advise Pete on any special precautions I should be aware of at the [REDACTED]? I'll be picking up email intermittently after 11 Oct, regularly before then. I will be in the over the Atlantic until the minute before [REDACTED], so any legal advice we should take this week.

Best,
Ryan

END OF MESSAGE

FROM: "Ryan D. Egeland" <ryan.egeland@oxamer.com>
SENT: 14/10/03 19:13:02
TO: JJC@carpmaels.com
CC: , pete.hotten@ogt.co.uk

3

SUBJECT: Patent Draft

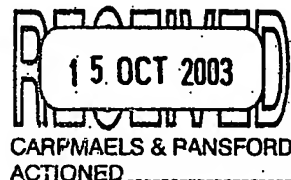
Jennie,

I hope you've now received the three further requests for information we discussed last week. I may be able to check email one more time before returning. Otherwise, I trust you find the information helpful in drafting the patent. My meeting with [REDACTED] Thursday, and there is a lab tour tomorrow (Wed) at 2 PM. Please contact Pete Hotten if you should have further queries.

Best regards,
Ryan

Ryan D. Egeland
Director - Oxamer
Oxford Gene Technology Operations Ltd.
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